DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/24/08 has been entered. Claims 1, 3-27 and 29-77 are pending.

Response to Arguments

2.   Applicant's arguments, see remarks pages 24-35, filed 4/24/08, with respect to 102(e) in view of Takahashi, Yamazaki, Simon and Shaffer have been fully considered and are persuasive. The rejection of the respective claims has been withdrawn except claims 24,25 and 26 in view of Yamazaki.

3.   Applicant's arguments filed 4/24/08 have been fully considered but they are not persuasive.

Applicant's state that Yamazaki does not teach the newly amend limitation of claim 24.

The examiner respectfully disagrees since Yamazaki teaches wherein the
locations ("outer edges" in col. 27, line 59 to col. 28, line 2) of the one or more
placement regions (since the outer edges represent the placement regions in coded
form) are proximate (or the same) to the locations (said outer edges) of the features (or
edges) in the template image (fig. 7B that includes fig. 6B thereon as discussed in col.
26, line 60 to col. 27, line 7).

Applicant's state that Yamazaki does not teach the newly amend limitation of
claim 25.

The examiner respectfully disagrees since Yamazaki teaches using the digital
camera to capture a template image (as shown in fig. 7B) with the digital camera in a
second mode (fig. 3A: INFORMATION INPUT MODE) wherein using the digital camera
to capture the template image comprises applying an image analysis technique (as
contemplated by a user) to the template image (fig. 7B in tangible form) to identify each
of the bounded regions (as being a TITLE section or KEYWORD #1 section for inputting
information by a user into the TITLE section or the KEYWORD #1 section) of the
template image.

4.   In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "placement regions...are identified at the time that the digital camera captures the template image...and do not need to be predefined..." on page 29 of the remarks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants state that Anderson does not teach the constructing limitation of claim 18.

The examiner respectfully disagrees since Anderson teaches corresponding to

claim 18 constructing (fig. 1, num. 108 does formatting which is the same as

constructing), at the data processing system (fig. 8, num. 800), one or more placement

regions (corresponding to fig. 2, num. 204) from the first digital image (corresponding to

fig. 1, num. 104) based upon features extracted (via fig. 1, num. 106 that identifies

characteristics of fig. 2, num. 200) from the first digital image (the output of fig. 1, num.

104) by applying an image analysis technique (or identifying characteristics performed

by fig. 8, num. 800) to the first digital image (the output of fig. 1 num. 104) to determine

a first placement region (as the text of fig. 2, num. 204 indicates) on the first digital

image (the output of fig. 1, num. 104 which corresponds to fig. 2, num. 200) for placing

a second digital image (since fig. 2, num. 204 is for placing an image within an image),

wherein locations of the one or more placement regions are based upon locations

("identify[ied]…position" in col. 3, lines 46-51) of the features (such as the shapes of fig.

2, num. 204) in the first digital image, wherein the image analysis technique is

automatically performed by the data processing system (as shown in fig. 8. num. 800) in

response to receiving the first digital image (via fig. 8, numerals 816-822 that

corresponds to the step of fig. 1, num. 104), and wherein the locations of the one or

more placement regions (the inside of fig. 2, num. 204) are proximate to the locations of

the features (such as the shape of fig. 2, num. 204 that surrounds the inside of fig. 2,

num. 204) in the first digital image.

Claim Objections

5.   Claims 10-12 are objected to because of the following informalities:

6.   Claim 10 "wherein identifying" lost its antecedent basis and will assume that it

corresponds to claim 1's determining.

        Claims 11 and 12 are objected for the same reasons as claim 10.

        Appropriate correction is required.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

8.   Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

        Claim 46 states "wherein locations of one or more placement regions are based

upon locations of features in the first digital image." Is this limitation accurate? Since this

limitation deviates from all the other independent claims that in general claim the

placement regions are based on the locations of the template image and not the

location of the images to be placed in the template image. The examiner will assume

that this limitation was a mistake and was intended to mean:

        "wherein locations of one or more placement regions are based upon locations

of features in the second digital image"

        since the second digital image is the template image that serves as the basis for

placing the first digital image and corresponds to the other independent claims.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10.   Claims 1,3-14,16-23,27,29-40,42-52,54-69 and 71-77 are rejected under 35

U.S.C. 102(e) as being anticipated by Anderson (US Patent 6,690,396 B1).

Regarding claim 18, Anderson discloses a method of generating a customized

digital image, the method comprising:

a)   receiving (fig. 8, numerals 816-822 receive), at the data processing

system (fig. 8, num. 800), a first digital image (corresponding to fig. 2, num. 200) using

an image capture device (fig. 8, num. 804) having a selectable mode (corresponding to

fig. 3, num. 312) for capturing a template image (via fig. 3, num. 318 that captures or

stores the template image corresponding to fig. 2, num. 200 that is used to generate a

template image via fig. 3, num. 312 and capture or store the template image via fig. 3,

num. 318);

b)   constructing (fig. 3, num. 312 formats which is the same as constructing),

at the data processing system (fig. 8, num. 800), one or more placement regions (as

shown corresponding to fig. 2, num. 204) from the first digital image (upon the output of

a scanner corresponding to fig. 1, num. 104) based upon features (such as shapes or

edges) extracted (via fig. 1, num. 106 that identifies the shapes or edges) from the first

digital image (the output of the scanner) by applying an image analysis technique (such

as edge and shape detection as discussed in col. 4, lines 41-62) to the first digital image

(said scanned image) to determine a first placement region (or "identify...the position" in

col. 3, lines 46-51) on the first digital image (said scanned image) for placing a second

digital image (since said identified position is used for placing another image on the

scanned image),

   b1)   wherein locations of the one or more placement regions (as shown

   in fig. 2, num. 204) are based upon locations (said identified positions as

   identified by the system of fig. 8, num. 800) of the features (said shapes and

   edges) in the first digital image (scanned image),

   b2)   wherein the image analysis technique (or edge and shape

   detection) is automatically performed by the data processing system (fig. 8, num.

   800) in response to receiving the first digital image, and

   b3)   wherein the locations of the one or more placement regions (fig. 2,

   num. 204 define a region with a border) are proximate to the locations of the

   features (such as borders of fig. 2, num. 204) in the first digital image; and

c)   placing (as the text of fig. 2, num. 204 states), at the data processing

system (fig. 2, num. 800), the second digital image (for placing inside the borders of fig.

2, num. 204) in the first placement region (fig. 2, num. 204) on the first digital image

(scanned representation of fig. 2, num. 200) to generate the customized digital image

(upon the output of fig. 3, numerals 316 or 320).

Regarding claim 19, Anderson discloses the method of claim 18 wherein the

second digital image (or image to be placed in fig. 2, num. 204) is a copy (or "thumbnail"

in col. 5, lines 57-59) of a third digital image.

Regarding claim 20, Anderson discloses the method of claim 18 further

comprising:

creating a link (said thumbnail) between the customized digital image (since fig.

2, num. 200 contains the thumbnail) and a third digital image (or high-resolution version

of the thumbnail), wherein the link (said thumbnail) enables access (via "clicking" as

known the thumbnail) to the third digital image using the customized digital image.

Claim 21 is rejected the same as claim 20. Thus, argument similar to that

presented above for claim 20 is equally applicable to claim 21.

Regarding claim 22, Anderson discloses the method of claim 18 wherein

receiving the second digital image comprises:

Scanning (via fig. 1 num. 104) a paper medium on which the first placement

region is marked (via stickers or magnets or image frame tape or plastic) to generate

the first digital image.

Claim 1 is rejected the same as claim 18. Thus, argument similar to that presented above for claim 18 is equally applicable to claim 1 except for the additional limitations of:

a)   a first set of digital images (corresponding to "second image" in col. 7, lines 51-53) captured using the image capture device (or "CCD" in col. 9, line 65) and

b)   determining (via a user), at the data processing system (represented in fig. 8 as num.818), a candidate digital image (from an implied set of images as said second image suggests) for each placement region (such as fig. 2, num. 204) of the one or more placement regions, a digital image (such as any one image form the set of said second image) from the first set of digital images captured using the image capture device (said CCD) to be placed in the placement region (fig. 2, num. 204); and

c)   for each placement region (fig. 2:204) of the one or more placement regions, placing (via a user that decides which of said images of said set of second image), at (since the user in locally at fig. 2:800) the data processing system (fig. 2:800), the candidate digital image (any one of said set of second image) determined (via said user) for the placement region (fig. 2, num.204) in the placement region on the first digital image (fig. 2, num. 200) to generate the customized digital image (for "morphing" in col. 7, lines 50-53 of any one of said images from said set of second image to another image of said set of second image).

Claims 3-5 are rejected the same as claims 20-22. Thus, argument similar to that presented above for claims 20-2 is equally applicable to claims 3-5.

Regarding claim 6, Anderson discloses the method of claim 1, further comprising:

photographing (or capturing an image), using the image capture device (said scanner),

a paper medium (or a flat object) on which the one or more placement regions have

been indicated (via said stickers or plastic or tape) to generate the first digital image (fig.

2, num. 200).

Regarding claim 7, Anderson discloses the method of claim 1 wherein the

extracted features include one or more bounded regions (which is a shape such as a

rectangle that bounds a region with a border or frame).

Regarding claim 8, Anderson discloses the method of claim 1 wherein extracted

features include one or more text fragments (corresponding to fig. 2, num. 208).

Claim 9 is rejected the same as claim 8. Thus, argument similar to that presented

above for claim 8 is equally applicable to claim 9.

Regarding claim 10, Anderson discloses the method of claim 1 wherein

identifying, for each placement region of the one or more placement regions, a digital

image from the first set of digital images to be placed in the placement region

comprises:

a)   determining (via the system of fig. 8, num. 800) image identification

information (such as said shape or edges) associated with at least a first placement

region of the one or more placement regions from the first digital image, the image

identification information identifying an attribute (such as a photo region versus a text

region) of a digital image to be placed in the at least first placement region; and

b)   identifying (via a user) a first digital image (for morphing) from the first set of digital images (since morphing images requires at least two images) to be placed in the at least first placement region (for morphing from a first image to the next in the same region) based upon the image identification information (such as said identified shape that specifies an image region versus a text region) associated with the at least first placement region.

Regarding claim 11, Anderson discloses the method of claim 10 wherein identifying the first digital image from the first set of digital images to be placed in the at least first placement region based upon the image identification information associated with the at least first placement region (for morphing purposes) comprises:

Identifying (via a user) a digital image from the first set of digital images (for morphing) as the first digital image (or morphing) if information associated with the digital image matches (as intended by the user that desires to morph a specific set of images at a pre-designated image location; thus, a matching is done when an image to be morphed is matched to a specified image region in contrast to a specified text region that does not match since text or handwriting is not an image or photograph as classified in Anderson) the image identification information associated with the at least first placement region.

Regarding claim 12, Anderson discloses the method of claim 1 wherein identifying, for each placement region of the one or more placement regions, a digital image from the first set of digital images to be placed in the placement region comprises:

a)   determining image identification information (said shape) associated with

at least a first placement region of the one or more placement regions from the first

digital image, the image identification information (said shape) identifying an attribute

(such as image region or text region) of a digital image to be placed in the at least first

placement region;

b)   determining a time stamp (or "amount of time...in a slide show" in col. 4,

lines 65 to col. 5, line 4 or "Metatag data" in col. 4, lines 65 to col. 5, line 4 in known to

have a time stamp) associated with each digital image in the first set of digital images;

and

c)   identifying (via a user) a first digital image from the first set of digital

images to be placed in the at least first placement region (for morphing from one image

to the next or the slideshow) based upon the image identification information (said

shape) associated with the at least first placement region and the time stamp (or said

slideshow time) associated with each digital image in the first set of digital images.

Claims 13 and 14 are rejected the same as claim 19. Thus, argument similar to

that presented above for claim 19 is equally applicable to claims 13 and 14.

Regarding claim 16, Anderson discloses the method of claim 1 wherein:

for each placement region of the one or more placement regions, a size of the

digital image placed in the placement region is determined (or identified) at the data

processing system by a size (fig. 2, num. 204 has 3 X 5 that is identified by fig. 8, num.

800) of the placement region.

Claims 17 and 27 are rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claims 17 and 27.

Claims 23,32,51,61 and 77 are rejected the same as claim 6. Thus, argument similar to that presented above for claim 6 is equally applicable to claims 23,32,51,61 and 77.

Claims 29-31,33-40 and 42 are rejected the same as claims 20-22,7-12,19,19 and 16, respectively . Thus, argument similar to that presented above for claims 20-22,7-12,19,19 and 16 is equally applicable to claims 29-31,33-40 and 42, respectively.

Regarding claim 43, Anderson discloses a digital camera (or "video capture device" in col. 9, line 67) that incorporates the system of claim 27.

Regarding claim 44, Anderson discloses a copying machine (or "scanner" in col. 9, line 65) that incorporates the system of claim 27.

Claims 45 and 46 are rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claims 45 and 46.

Claims 47-50 are rejected the same as claims 19-22. Thus, argument similar to that presented above for claims 19-22 is equally applicable to claim 47-50.

Claim 52 is rejected the same as claims 1 and 19. Thus, argument similar to that presented above for claims 1 and 19 is equally applicable to claim 52

Claim 54 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 54.

Claims 55 and 56 are rejected the same as claims 43 and 44. Thus, argument

similar to that presented above for claims 43 and 44 is equally applicable to claims 55

and 56.

Claim 57 is rejected the same as claim 1. Thus, argument similar to that

presented above for claim 1 is equally applicable to claim 57 except for the additional

limitation of a product as disclosed in Anderson in fig. 8, num. 804.

Claims 58-60 and 62-69 are rejected the same as claims 20-22,7-(13 and 16 as

a whole for claim 68) and 14. Thus, argument similar to that presented above for claims

20-22,7-12,(13 &16) and 14, respectively is equally applicable to claims 58-60 and 62-

69.

Claims 71 and 72 are rejected the same as claim 57. Thus, argument similar to

that presented above for claim 57 is equally applicable to claims 71 and 72.

Claims 73-76 are rejected the same as claims 19-22. Thus, argument similar to

that presented above for claims 19-22 is equally applicable to claims 73-76.

11.   Claims 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by

Yamazaki (US Patent 6,999,117 B2).

Regarding claim 24, Yamazaki discloses a method of generating a customized

digital image using a digital camera, the method comprising:

a)   capturing one or more images using the digital camera with the digital

camera in a first mode (fig. 3A: PHOTOGRAPH MODE);

b)   capturing a template image by imaging a paper medium with the digital

camera in a second mode (fig. 3A: INFORMATION INPUT MODE);

c)   determining (via fig. 4, num. 150) in the digital camera one or more

placement regions (as shown in fig. 7B: "SPACE...") from the template image (fig. 7B

that contains fig. 6B thereon), each placement region (as shown in fig. 7B) of the one or

more placement regions identifying a location (or "each blank space's location" in col.

27, lines 2-7) on the template image (fig. 7B with barcode) for placing an image from the

one or more images captured using the digital camera, wherein the locations (or "outer

edges" in col. 27, line 59 to col. 28, line 2) of the one or more placement regions (since

said outer edges represent the placement regions in coded form) are proximate (or the

same) to the locations (said outer edges) of the features (edges) in the template image

(fig. 7B);

d)   identifying in the digital camera (via the output of fig. 5B, num. 230

represents that an identified item from a list was selected and known to the camera), for

each placement region of the one or more placement regions, an image from the one or

more images to be placed in the placement region; and

e)   for each placement region (corresponding to fig. 5B:220-224) of the one or

more placement regions, placing (corresponding to fig. 5B:232) a copy of an image (that

is a digital version of a tangible illustrated image) from the one or more images identified

(in said step 230) for the placement region in the placement region to generate the

customized digital image (corresponding to fig. 7B that has been synthesized).

Regarding claim 25, Yamazaki discloses a method of generating a customized

digital image using a digital camera including a button, the method comprising:

a)   using the digital camera to capture one or more images with the digital

camera operative in a first mode (fig. 3A: PHOTOGRAPH MODE), wherein using the

digital camera to capture the one or more images comprises capturing the one or more

images using the digital camera without selecting the button of the digital camera (so as

to not enter another mode as fig. 3A shows two other modes);

b)   using the digital camera to capture a template image (fig. 7B) with the

digital camera in a second mode (fig. 3A: INFORMATION INPUT MODE), the template

image comprising one or more bounded regions (as shown in fig. 7B), each bounded

region of the one or more bounded regions identifying a location (via a label such as

TITLE) on the template image for placing an image (corresponding to fig. 7B: "SPACE

FOR...ILUSTRATION) of the one or more images captured using the digital camera,

wherein using the digital camera to capture the template image comprises:

b1)   selecting the button of the digital camera (so as to enter the

INFORMATION INPUT MODE);

b2)   using the digital camera to capture an image of the paper medium

(such as a "map" in col. 26, lines 42-59 which is known to be in paper form or

"photographic image" form in col. 26, lines 42-59 which is a photograph or picture

which is known to be in paper form) while the button of the digital camera is

selected (in said INFORMATION INPUT MODE); and

b3)   applying an image analysis technique (as contemplated by a user)

to the template image (as shown in fig. 7B) to identify each of the bounded

regions of the template image (for placing the map or photo of a map on a

respective labeled region of the template image); and

b4)   obtaining the customized image (corresponding to fig. 7B) from the

digital camera, wherein the customized digital image is generated by placing a

copy of at least one image from the one or more images in at least one bounded

region on the template image.

Regarding claim 26, Yamazaki discloses the method of claim 25 wherein:

using the digital camera to capture the template image further comprises:

a)   imprinting the one or more bounded regions on a paper medium (as

implied by the paper sheet of fig. 7B); and

b)   using the digital camera to capture the one or more images comprises

capturing the one or more images using the digital camera without selecting the button

of the digital camera (already addressed in claim 25, above).

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

13.   Claims 15,41 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Anderson (US Patent 6,690,396 B1) or Anderson I in view of Anderson (US Patent

5,933,137) or Anderson II.

Regarding claim 15, Anderson I does not teach cropping the digital image to fit

the placement region, and instead teaches generating a thumbnail image which is a

smaller version of a larger image to fit the placement region.

Anderson II teaches a smaller thumbnail image as shown in fig. 8, num. 700 that

is a "cropped" in col. 11, lines 58-61.

It would have been obvious at the time the invention was made to one of ordinary

skill in the art to modify Anderson I's thumbnail image with Anderson II's cropped

thumbnail, because Anderson II's cropped thumbnail images are intended as

navigational aides and saves screen space as discussed in col. 11, line 58 to col. 12,

line 9. Thus, Anderson I's user interface can be improved with Anderson II's cropped

thumbnails.

Claims 41 and 70 are rejected the same as claim 15. Thus, argument similar to

that presented above for claim 15 is equally applicable to claims 41 and 70.

14.   Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Anderson (US Patent 6,690,396 B1) as applied to claim 52 above, and further in view of

Froessl (US Patent 5,133,024) in view of Hyodo et al. (US Patent 7,034,881 B1).

Regarding claim 52, Anderson primarily uses a scanner, but teaches other

devices can be attached to fig. 8, num. 800 such as cameras and CCDs.

Froessl teaches using both a scanner and a camera as shown in fig. 1:28 and

12.

It would have been obvious at the time the invention was made to one of ordinary

skill in the art to modify Anderson's scanner with the teaching of Froessl's teaching of a

using a camera with scanner, because the camera compensates for a document that is

too large for the scanner to properly scan a document to obtain an image of the

document.

The combination still does not teach claim 53 of a first button of a camera, but

teaches using cameras.

Hyodo teaches a camera with a template button as shown in fig. 12, num. 23 that

indicates that template images are available and stored or captured.

It would have been obvious at the time the invention was made to one of ordinary

skill in the art to modify Froessl's teaching of a camera with scanner with Hyodo's

camera with a template button, because Hyodo's button provides useful information to a

user viewing an image as shown by image of fig. 12.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Rosario whose telephone number is (571) 272-7397. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Rosario/   /Matthew C Bella/
Examiner, Art Unit 2624   Supervisory Patent Examiner, Art
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